



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20531
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,941	01/15/2002	Hai-Quan Mao	GPT-005.03 (22140-503)	5592

29755 7590 01/09/2003

FOLEY HOAG LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02110-2600

EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/047,941	Applicant(s) MAO ET AL	
Examiner Peter Szekely	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 134-154 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 134-154 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 134-154 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not have a "Q", which can be O or NR', where R' is H or alkyl. As a matter of fact there is no "Q" mentioned in the entire specification. In the specification the double bonds are always connected to oxygen. Furthermore there is no mention of "L" being any non-interfering substituents, branch or straight chain aliphatic group of any undetermined length, a cyclic aliphatic group, a divalent aryl group or a polymeric group. L has to be a divalent branched or straight chain aliphatic group having 1-20 carbon atoms. See page 9, last line and page 10, first line, of the instant specification.

3. Claims 134-154 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for oxygen atoms being connected to double bonds and "L" being a divalent branched or straight chain aliphatic group having from 1-20 carbon atoms, does not reasonably provide enablement for the non-existent "Q" being connected to said double bonds or said non-existent "Q" being NR', wherein R is H or alkyl, or for "L" being any just any kind of non-interfering substituent, branched or

Art Unit: 1714

straight chain aliphatic group of undetermined length, a cyclic aliphatic group, a divalent aryl group or a polymeric group. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. See page 9, last line and page 10, first line of the instant specification.

Response to Arguments

4. Applicant's arguments filed 12/09/02 have been fully considered but they are not persuasive. There is no mention of "Q" in the entire specification. If applicants wish to argue that statement, they should point out the page(s) and line(s) where "Q" and its possible meanings are described. The specification only shows formulas where oxygen is connected to the double bonds. As far as the possible meanings of "L" are concerned, the specification clearly states on the last line of page 9 and on the first three line of page 10, that "L" can be any divalent branched or straight chain aliphatic group having 1-20 carbon atoms, so long as it does not interfere with the polymerization or biodegradation reactions of the polymer". The following lines on page 10, ending in line 17, further restrict the possible meaning of "L", they do not expand it. "L" cannot be just any kind of non-interfering substituent, a branched or straight chain aliphatic group exceeding 20 carbon atoms, a cyclic aliphatic group, a divalent aryl group or a polymeric group. The instant claims are not part of the original specification. The rejections are maintained.

5. The rejection under the second paragraph of 35 U.S.C. section 112, and the double patenting rejections are withdrawn in light of applicants' response.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is 703-308-2460. The examiner can normally be reached on Tuesday-Friday 7:00 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 10/047,941
Art Unit: 1714

Page 5

A handwritten signature in black ink, appearing to read 'Peter Szekely', with a stylized, flowing script.

Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
January 8, 2003